

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-3 and 6-9 are rejected under 35 USC 102(b) over the U.S. patent to Baumann.

The Examiner also indicated that Claim 4 is allowed, and Claim 5 is allowable.

At the same time the Examiner objected to the specification and the claims.

In connection with the Examiner's objections and rejections, it is respectfully submitted that the present application relates to a hand-held power tool comprising a replaceable tool fitting, wherein at least one movably supported profiled element (15) is formed or situated on an output spindle (1) or on the tool fitting (11) of the hand-held power tool, and wherein at least one profiled recess (7) is formed in or situated on the output spindle (1) or the tool fitting (11) in a manner such that, when the tool fitting (11) is slid onto the output spindle (7), the at least one profiled element (15) engages in the at least one profiled recess (7), thereby locking the tool fitting (11) on the output spindle (1) in the axial direction

and ensuring that it is driven in a rotational manner, means (6, 8, 14) being provided that guide the profiled element (15) into the profiled recess (7) when the tool fitting (11) performs a rotational and sliding motion on the working spindle (1) (see: application page 6, claim 1, and figure 1). A similar embodiment is known from D1.

Contrary to the examiner's view, the features of Claim 2 are not known in the U.S. patent to Baumann, in particular with regard for specifically defining the concept of "a rotate-into-engagement profile": the U.S. patent to Baumann discloses a device, in the case of which a rotational motion may be carried out via a toothing (3), which has contact surfaces that taper in their axial direction, when a tool fitting is slid into place, but the device described in the U.S. patent to Baumann does not include a circumferential projection with separated grooves, nor does it include a "rotate-into-engagement profile" that is designed to glide along the projection in the circumferential direction so that it may then be inserted into a groove.

It is respectfully submitted that the new features of the present invention which are now defined in new Claim 10 are not disclosed in the prior art applied by the Examiner against the original claims, in particular in the U.S. patent to Baumann.

In connection with this rejection it is believed to be advisable to cite the decision In Re: Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Baumann does not disclose each and every element of the present invention as now defined in Claim 10.

Therefore, it is respectfully submitted that the anticipation rejection applied by the Examiner against the original claims should be considered as not tenable with respect to Claim 10 and should be withdrawn.

The patent to Baumann also does not contain any hint, suggestion or motivation for such features. It cannot be considered as obvious to arrive at the present invention as defined in Claim 10 from the teaching of the patent to Baumann. In order to arrive at the present invention from the patent to Baumann, the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention as defined in Claim 10. However, it is

known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of this it is believed that Claim 10 cannot be considered as obvious from this reference.

As for the dependent claims, these claims depend on Claim 10, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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